

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARJORIE B. MEDINA

Appeal No. 2004-1956
Application No. 09/832,211

ON BRIEF

Before GARRIS, WALTZ, and PAWLIKOWSKI, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 13 through 24, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to a method of detaching microorganisms from, or inhibiting microbial attachment to, animal or poultry carcasses or seafood or parts thereof, where the method consists of contacting animal or poultry

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carcasses or seafood or parts thereof at least once with an effective amount of at least one member of the group consisting of a (i) polysulfated polysaccharide, (ii) carboxymethyl cellulose, (iii) guanidine or arginine, optionally together with Tween® and sodium chloride, and (iv) mixtures thereof (Brief, page 2).

Appellant does not provide any statement as to whether the claims do not stand or fall together (Brief, page 3). Therefore, as noted by the examiner (Answer, page 2, ¶(7)), the claims stand or fall together. See 37 CFR § 1.192(c)(7) (2000); *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002).

Accordingly, we select claim 13 from the grouped claims and decide the ground of rejection in this appeal on the basis of this claim alone. Representative independent claim 13 is reproduced below:

13. A method of detaching microorganisms from, or of inhibiting microbial attachment to, animal or poultry carcasses or seafood or parts thereof, said method consisting of contacting animal or poultry carcasses or seafood or parts thereof at least once with at least one member of the group consisting of (i) a polysulfated polysaccharide, (ii) carboxymethyl cellulose, (iii) guanidine or arginine, optionally together with Tween and sodium chloride, (iv) and mixtures thereof, in an amount effective to detach microorganisms from, or inhibit microbial attachment to, said animal or poultry carcasses or seafood or parts thereof.

The sole rejection on appeal is of claims 13-24 under the second paragraph of 35 U.S.C. § 112 for being indefinite (Answer,

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page 3). We *affirm* this ground of rejection for the reasons stated in the Answer and those reasons set forth below.

OPINION

The examiner concludes that the claims are indefinite because they include the trademark "TWEEN" (Answer, page 3). The examiner asserts that this trademark cannot be used in the claims because the composition covered by this trademark is solely within the control of the trademark owner and may be subject to change over time at the sole discretion of the owner, thus rendering the scope of the claims indefinite (*id.*). The examiner states that the use of the trademark TWEEN must be capitalized wherever it occurs and be accompanied by the generic terminology, citing the *Manual of Patent Examining Procedure (MPEP)*, §§ 608.01(v) and 2173.05(u) (*id.*).

Appellant correctly notes that it is well settled that the initial burden of establishing a *prima facie* basis to deny patentability, on any ground, rests with the examiner (Brief, page 3, citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). Appellant argues that the examiner has failed to show that those skilled in the art would not understand what is claimed (Brief, page 4; Reply Brief, pages 1-2). Appellant states that many patents have issued with the term "Tween" in their claims

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(Brief, page 4; Reply Brief, page 2). Therefore appellant argues that this term is well understood by one of ordinary skill in the art.

Whether a claimed invention is indefinite is a question of law. See *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). "The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope." *In re Warmerdam*, *supra*. The presence of a trademark in a claim is not, *per se*, improper under 35 U.S.C. § 112, second paragraph, but the claim must be carefully analyzed to determine how the trademark is used in the claim. It is important to recognize that a trademark is used to identify a source of goods, and not the goods themselves. Thus if the trademark is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of section 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020, 1021-22 (Bd. Pat. App. 1982). The claim scope is uncertain since the trademark cannot be used properly to identify any particular material or product. See MPEP, § 2173.05 (u), 8th ed., Rev. 2, May 2004, pp. 2100-218 to 2100-219.

Analyzing claim 13 on appeal, we note that "Tween" is used to identify or describe a specific material, i.e., a class of

surfactants (see the specification, page 3, first paragraph; and page 4, ll. 12-13). Furthermore, the use of "Tween" in the claimed method is not merely as a carrier or inert material but some physical or chemical characteristic of the material is involved in the invention. The use of a specific surfactant ("Tween 80") with sodium chloride was shown to enhance the effectiveness of guanidine and arginine in detaching bacteria bound to collagen, while "Tween 20" and sodium chloride had a smaller effect (specification, page 21, ll. 3-5). Therefore the surfactant which has a beneficial effect on the properties in the claimed method must be specifically identified and not left to conjecture. We note that the art has long held "Tween" and "Tween 80" as separate entities.¹

Accordingly, although specific "Tweens" (e.g., Tween ® 80, Tween ® 20, Tween ® 60, etc.) may have a well known structure, the trademark TWEEN identifies the source of a broad class or mixture of surfactants, and this broad class may be changed at the sole discretion of the trademark owner.

As discussed above, the use of trademarks in the claims of a patent must be considered on a case-by-case basis. Therefore

¹See *The Merck Index of Chemicals and Drugs*, 6th ed., pp. 770, 897, and 984, Merck & Co., Inc., 1952 (copy attached). "Tween ® 80" is also known as "Polysorbate 80."

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appellant's argument that 248 patents with "Tween" in the claims have been located in a computer search does not affect the prosecution of this application. See *In re Giolito*, 530 F.2d 397, 400, 188 USPQ 645, 648 (CCPA 1976).

For the foregoing reasons and those set forth in the Answer, we agree with the examiner's conclusion that the term "Tween" renders the scope of claim 13 on appeal indefinite to one of ordinary skill in the art. Therefore, we affirm the examiner's rejection of claim 13, and claims 14-24 which stand or fall with claim 13, under the second paragraph of section 112.

The decision of the examiner is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Bradley R. Garris

BRADLEY R. GARRIS)
Administrative Patent Judge)

Thomas A. Waltz

THOMAS A. WALTZ)
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APPEALS
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